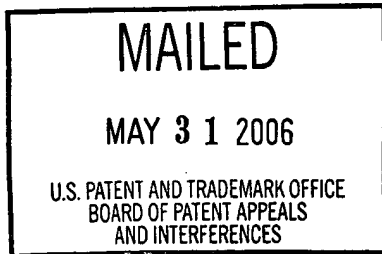


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte HOWARD B. SOSIN

Appeal No. 2005-2680
Application No. 09/248,515

HEARD: JANUARY 24, 2006

Before FRANKFORT, CRAWFORD and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on appellant's request for rehearing under 37 CFR § 41.52(a)(1), filed April 10, 2006, of our decision mailed February 10, 2006, wherein we affirmed all of the examiner's rejections with the exception of the rejection of claim 53 as being unpatentable over Ahn (US Pat. No. 6,015,354) in view of Hirose (US Pat. No. 5,564,991) and Scheie (US Pat. No. 5,120,062). Appellant requests rehearing of the decision only with regard to the affirmance of the examiner's decision to reject claim 53 as being anticipated by Thompson (US Pat. No. 3,961,796).

Specifically, appellant argues that this panel has overlooked important statements in at least the Loesch declaration and has misapplied the legal standard to be met by the Hampford and Loesch declarations (request, page 3). In essence, appellant's request urges that the teachings of Thompson with respect to lean angle and loft angle are ambiguous at best and that, as such, it was error for this panel to require the Hampford and Loesch declarations to rebut a clear teaching.

With respect to the teachings of Thompson, appellant argues that Figure 2 does not itself include any indication of any angle or any indication that it is intended to represent an accurate, scaled drawing (request, page 3). While Figure 2 probably cannot reasonably be relied upon to quantitatively establish precise dimensions or angles without at least an indication that it is drawn to scale, it does unequivocally depict a positive loft angle with the shaft in a non-zero lean orientation with respect to the vertical (i.e., the perpendicular to the horizontal surface 34).

Appellant also argues that there is no indication that the golf club head shown in Thompson's Figure 4 is in the same position as that shown in Figure 2 (request, page 3). This is simply not true. Figure 4 is identified as a section taken on lines 4-4 of Figure 1 (column 2, line 4), which, as indicated by the lines 4-4 and arrows in Figure 1, is viewed from the toe end direction, while Figure 2 is a toe end elevation of the Figure 1 head (column 1, line 68). Thus, the descriptions of Figures 2 and 4 indicate that the head is in the same position in both.

As for whether the club of Thompson's Figure 2 is shown in a de-lofted state or in its design loft state, as explained on page 6 of our decision, a "design loft" as used by appellant is merely the inclination of the face from the vertical in the intended use of the club as the face strikes the ball. As established in appellant's specification, however, in practice, not all golfers strike a ball with a particular club in the same orientation. In other words, one golfer's or manufacturer's intended use orientation for a particular club may differ from that of another golfer or manufacturer, while the structure of the club is nonetheless the same.¹ The "design loft" limitation of claim 53 is thus necessarily a limitation of intended use. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Appellant's argument on page 4 of the request that the head/shaft connection depicted in Figure 2 is an "unexplained feature" of that figure that is not clearly disclosed is not well founded. The showing of a club having a shaft in a non-zero lean orientation in Figure 2 is unambiguous. The statement in the Loesch declaration that declarant would expect that no lean angle was intended by Thompson, based simply on the fact that such was not standard practice in the art at the time of appellant's invention, conveniently dismissed the unequivocal illustration in Figure 2 without any

¹ Stated differently, a single club may at once be one golfer's club with a 27 degree loft, 3 degree lean angle and a first bounce characteristic and another golfer's club with a 30 degree loft, zero lean angle and a second bounce characteristic, especially in light of the differences in golfers' swings discussed on page 2 of appellant's specification.

sound basis to do so. The further statement in the Loesch declaration that the declarant understands the Figure 2 depiction to “reflect an imprecise rendition of a three-dimensional object in two dimensions rather than an intended deviation from the norm” evidences a misapprehension on the part of the declarant of patent drawing conventions.

In light of the above, appellant's request for rehearing has not persuaded us of any error in our decision. Accordingly, appellant's request is granted to the extent that we have reconsidered our decision but is denied with respect to our making any modification thereof.

CONCLUSION

Our affirmance of the examiner's decision as set forth in our decision mailed February 10, 2006 is maintained.

DENIED


MURRIEL E. CRAWFORD
Administrative Patent Judge

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